

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Glatzer et al.

EXAMINER: Barts, Samuel A.

SERIAL NO.: 10/697,919

GROUP ART UNIT: 1621

FILED: October 30, 2003

DATED: July 6, 2011

FOR: PROCESS FOR MANUFACTURE OF BLOCKED MERCAPTOSILANE COUPLING
AGENTS

Mail Stop: PETITION
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313

REQUEST FOR RECONSIDERATION

Sir:

This is a request for reconsideration of the decision mailed on May 9, 2011 in which Applicant's petition for revival of the above-referenced application was dismissed.

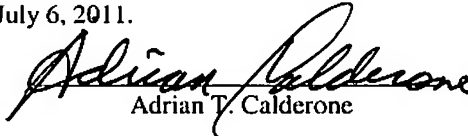
Applicants unintentionally failed to reply to a Notice of Allowance mailed on December 4, 2006 to GEAM Silicones-60si at One Plastics Avenue, Pittsfield, MA 01201-3697 ("GE Silicones").

The current owner of this patent application, Momentive Performance Materials Inc. ("Momentive"), acquired the assets of the General Electric Company ("GE") Silicones business from GE by reason of a certain purchase and sale agreement executed December 4, 2006.

Certificate of EFS-Web Transmission

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via the Office's electronic filing system on July 6, 2011.

Dated: July 6, 2011


Adrian T. Calderone

After the execution of the agreement, in early December of 2006 there was a transitioning in which a large number of certain patent applications were being legally and physically transferred from GE Silicones to Momenitive.

For reasons unknown to Applicants or Momenitive's legal staff, the physical document of the Notice of Allowance had not been found, docketed, or communicated to Dilworth & Barrese, LLP, Momenitive's outside legal counsel, for handling. It appears that the Notice of Allowance had not been connected with the appropriate file folder.

Furthermore, the Notice of Abandonment mailed on April 5, 2007 also appears to have been lost in the transition. In an e-mail of March 30, 2007 (copy enclosed), then legal assistant Ms. Annita E. Lise of Momenitive, inquired of Ms. Helene Harrison, who was at the time in charge of docketing at Dilworth & Barrese, LLP whether any further documents had been received from the U.S. Patent and Trademark Office (USPTO) after filing by the undersigned of a response on September 7, 2006. Nothing further had been received at Dilworth and Barrese, LLP, and no further correspondence was in Momenitive's physical file folder or internal electronic records.

A Notice of Change of Address in the above-captioned application was filed with the USPTO on January 23, 2009. In the Notice, of Change of Address the correspondence address was changed to Momenitive Performance Materials, Inc. c/o Dilworth and Barrese, LLP, 333 Earle Ovington Blvd., Uniondale, NY 11553. None of the Applicants, Momenitive's legal staff, or the legal staff at Dilworth & Barrese, LLP were aware at that time that the above-captioned application had become abandoned.

The abandoned status of the above-captioned application was discovered on or about January 3, 2011. In an e-mail of January 3, 2011 (copy enclosed), Ms. Helene Harrison of Dilworth & Barrese, LLP forwarded a copy of the April 5, 2007 Notice of Abandonment to Joseph S. Ostroff, in-house Intellectual Property Counsel for Momentive, stating "Attached is a Notice of Abandonment for the above case. It is dated 2007 and looks like it was sent to GE and never transferred to MPM. Please let me know if you want us to file a Petition to Revive." In an e-mail reply on the same day (copy enclosed) Joseph S. Ostroff replied that "The abandonment of this case (US 10/697,919) was unintentional. Please take the necessary steps to attempt to revive this case. If you need any information from Momentive to complete the petition, let us know. Keep me apprised of the status."

Subsequent to receipt of instructions from Joseph S. Ostroff, the Law firm of Dilworth & Barrese, LLP proceeded to prepare a Petition for Revival of the above-captioned application. The Petition was filed March 14, 2011.

Meanwhile, Momentive had been prosecuting corresponding foreign cases in China (Chinese Application No. 200380108209.4, granted October 10, 2007)), the European Patent Office (EP Application No. 03 781 640.2, pending), Japan (JP 2005-504464, granted January 29, 2010), Korea (KR 2005-7007990, granted March 23, 2011), and Brazil (PI 0315439-4, pending) as national phase applications of a PCT application (PCT/US/03/34737) filed October 30, 2003 claiming priority to the U.S. Provisional Application No. 60/423,577 filed November 4, 2002, to which the above captioned application also claims priority. Prosecution of these foreign counterparts provides further indication that Momentive did not intend to abandon patent protection for the subject matter of this application.

In summary,

1. The above-captioned application had been allowed by the USPTO.
2. Due to the physical transfer of cases from GE to Momentive occurring in December 2006, it is the Applicants' belief that the Notice of Allowance mailed by the USPTO to GE was inadvertently misplaced and was not found and docketed until on or about January 3, 2011.
3. Several foreign applications corresponding to the above-captioned application were filed and have been maintained in foreign countries.

In view of the above, Applicants state that the entire delay in acting upon the Notice of Allowance for the above-captioned application was unintentional.

Accordingly, reconsideration of the decision to dismiss Applicant's Petition for Revival is respectfully requested.

Respectfully submitted



Adrian T. Calderone
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Attorney for Applicant(s)

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Tel: (516) 228-8484
Fax: (516) 228-8516

Lise, Annita E (Momentive Performance Materials)

From: Helene Harrison (hharrison@dilworthbarrese.com)
Sent: Friday, March 30, 2007 9:11 AM
To: Lise, Annita E (Momentive Performance Materials)
Subject: Re: Docket Nos. : US 142759-2 - Yours: 1302-50

No, that's the last thing I have in my database.

/helene
Helene Harrison
Office Manager
Dilworth & Barrese, LLP
333 Earle Ovington Blvd.
Uniondale, New York 11553
(516) 228-8484
hharrison@dilworthbarrese.com

----- Original Message -----

From: Lise, Annita E (Momentive Performance Materials)
To: Helene Harrison
Sent: Friday, March 30, 2007 9:06 AM
Subject: Docket Nos. : US 142759-2 - Yours: 1302-50

Helene ...

On checking my term books I noted that Adrian Calderone filed a response on September 7, 2006. Have you received anything else on this case? Let me know, at your convenience. Many thanks.

Regards,

Annita
Phone: 914-784-4883
Fax: 914-784-4881
E-Mail: annita.lise@momentive.com

Adrian Calderone

From: "Helene Harrison" <hharrison@dilworthbarrese.com>
To: "Ostroff, Joseph " <Joseph.Ostroff@momentive.com>
Cc: "Angarola, Alison " <alison.angarola@momentive.com>; "Hayden, Karen A " <Karen.Hayden@momentive.com>
Sent: Monday, January 03, 2011 11:32 AM
Attach: 1302-50.pdf
Subject: 1302-50 - 142759
Hi Joe

Attached is a Notice of Abandonment for the above case. It is dated 2007 and looks like it was sent to GE and never transferred to MPM.

Please let me know if you want us to file a Petition to Revive.

Thanks,
Helene

Helene Harrison
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DILWORTH & BARRESE, LLP
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1000 Woodbury Road, Suite 405
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7/1/2011

Adrian Calderone

From: "Ostroff, Joseph " <Joseph.Ostroff@momentive.com>
To: "Helene Harrison" <hharrison@dilworthbarrese.com>
Cc: "Angarola, Alison " <alison.angarola@momentive.com>; "Hayden, Karen A " <Karen.Hayden@momentive.com>; "Pohl, Eric R " <Eric.Pohl@momentive.com>
Sent: Monday, January 03, 2011 2:13 PM
Attach: 1302-50.pdf
Subject: RE: 1302-50 - 142759
Dear Helene,

The abandonment of this case (US 10/697,919) was unintentional. Please take the necessary steps to attempt to revive the case. If you need any information from Momentive to complete the petition, let us know. Keep me apprised of the status.

Please check to see if there was any art cited in the corresponding foreign cases that needs to be cited in the US case; if so, then I authorize the filing of an RCE to get that art in front of the Examiner. In conjunction with this review, please also work with Eric Pohl to review the claims and amend them if necessary. If there is no art that needs to be cited, it would be unlikely that we would submit any amendments, and we would just pay the issue and publication fees.

Thanks,
Joe

From: Helene Harrison [mailto:hharrison@dilworthbarrese.com]
Sent: Monday, January 03, 2011 10:32 AM
To: Ostroff, Joseph
Cc: Angarola, Alison ; Hayden, Karen A
Subject: 1302-50 - 142759

Hi Joe

Attached is a Notice of Abandonment for the above case. It is dated 2007 and looks like it was sent to GE and never transferred to MPM.

Please let me know if you want us to file a Petition to Revive.

Thanks,
Helene

Helene Harrison
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